

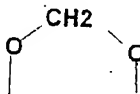
REMARKS/ARGUMENTS

Reconsideration of this application is requested. Claims 1-17 are in the case.
Claim 18 has been canceled without prejudice.

I. THE 35 U.S.C. §112, SECOND PARAGRAPH, REJECTION

Claims 1 and 11 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite for the reasons detailed on page 3 of the Action. This rejection is respectfully traversed.

Claim 1 stands rejected in view of the substituent OCH₂O in which it is alleged that it is unclear what can be encompassed by this substituent as the second O does not have a terminal group. In response, the term OCH₂O is a methylenedioxy group



Support appears in Examples 58a, 58c, 59a and 59c (page 47, scheme 14), as well as at page 10 (third and fourth paragraph, first line), at page 14, last three compounds (5T2892, ST2891 and 5T2933), at page 15, first compound (5T2934), and in claim 1 (fourth, seventh and eighth paragraph, first line).

Claim 2 stands rejected as containing compounds with typographical errors and no identification. Those errors have been corrected in the present response. No new matter is entered.

Withdrawal of the outstanding 35 U.S.C. §112, second paragraph, rejection is now believed to be in order. Such action is respectfully requested.

II. THE OBVIOUSNESS REJECTION

Claims 1 and 11 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent 5,858,995 to Kawai et al. That rejection is respectfully traversed.

The compounds of formula I disclosed by Kawai are described as possessing bone resorption and bone metabolism inhibiting activity (Kawai, Abstract and col. 1, lines 20-30). The compounds are stated to be used for the prophylactic and/or therapeutic treatment of bone diseases characterized by abnormal bone metabolism, such as osteoporosis, hyper-calcemia, hyperparathyroidism, Paget's bone disease, osteolysis, hypercalcemia of malignancy with or without bone metastasis, rheumatoid arthritis, periodontitis, osteoarthritis, ostealgia, osteopenia, cancer cachexia, or the like (Kawai, col. 1, lines 20-30). While the diseases listed in Kawai are commonly ascribed to bone disease, in particular to bone resorption and bone metabolism, it is noted that there is no evidence provided in by Kawai supporting any activity of the disclosed compounds.

In contrast, the compounds as claimed in the present application have a different utility. Thus, the compounds of the present invention possess cytotoxic-type anticancer activity, as well as antiangiogenic-type anticancer activity and activity in reducing cancer metastases (see page 12 of the present application). Particular cancers which may be treated by the compounds of the present invention are: sarcoma, carcinoma, carcinoid,

bone cancer, endocrine cancer, lymphoid leukaemia, myeloid leukaemia, monocytic leukaemia, megakaryocytic leukaemia or Hodgkin's disease. Further diseases which can be treated by the compounds of the present invention are related to abnormal angiogenesis: arthritic disease, tumors, metastatic spread, diabetic rethinopathy, psoriasis, chronic inflammation and atherosclerosis. Importantly, the specification provides support for pharmacological activity, beginning at page 50.

The Action argues that the claimed compounds would have been obvious to one of ordinary skill since they differ by the replacement of a methyl group for a hydrogen atom. However, despite the allegedly small structural change, the person of ordinary skill could not have predicted that such a small structural modification to a group of compounds, known to be active as bone resorption inhibitors, would have resulted in compounds possessing a different utility, namely cytotoxic-type anticancer activity, antiangiogenic-type anticancer activity and the capability of treating diseases related to abnormal angiogenesis. Based on this lack of predictability, the skilled artisan would not have been motivated to modify the Kawai compounds to arrive at the presently claimed compounds, as there would have been no expectation that a different utility would result.

Absent any motivation to modify the Kawai compounds, it is clear that a *prima facie* case of obviousness has not been generated in this case. Reconsideration and withdrawal of the outstanding obviousness rejection are accordingly respectfully requested.

III. CLAIM OBJECTIONS

Claims 1, 2 and 11 have been objected to for the reasons detailed on page 6 of the Action. In response, and without conceding to the merit of these rejections, claim 1 has been amended to clarify the situation with respect to the substituent R10 and claim 2 has been amended so as to be in proper Markush format. With regard to Claims 1, 2 and 11 being dependent on subject matter that has been withdrawn from consideration, it is requested that the subject matter withdrawn be rejoined once allowable subject matter is indicated. Withdrawal of the claim objections is now respectfully requested.

IV. DRAWINGS

The drawing (Figure 1) has been objected to in that it is unclear what the black and white bars represent. In response, the specification has been amended to include a brief description of the drawing which the significance of the black and white bars is explained. Basis appears in the second complete paragraph on page 57 of the application. No new matter is entered. Withdrawal of the objection to the drawings is now respectfully requested.

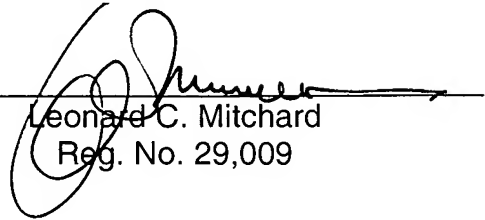
Favorable action is awaited.

SIMONI ET AL.
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Respectfully submitted,

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